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MEHDI SHEIKERZ  
STAAS & HALSEY LLP  
1201 NEW YORK AVENUE,NW  
SUITE 700  
WASHINGTON, DC 20005

EXAMINER

IRSHADULLAH, M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/187,749

Applicant(s)

UTSUMI ET AL.

Examiner

M. Irshadullah

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2004 has been entered.

2. This communication is in response to the amendments filed February 18, 2004.

### ***Summary Of Instant Office Action***

3. Applicant's arguments, filed February 18, 2004, regarding claims 1-9 rejected under U.S.C. 1043, Office Action mailed May 19, 2003 have been considered and are responded below.

4. Applicant's amendments to claims 1, 8 and 9 and new claim 10 have been entered.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al (US Patent 5,553,139) in view of Hasebe et al (US Patent 5,392,351).

Ross et al teach:

**Claim 1.** A license devolution apparatus (Title and col. 1, lines 7-8)

b) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first license information (Ross et al: Col. 4, lines 22-24, col. 6, lines 40-59 {specifically lines 49, 52-56}, col. 7, lines 28-40, 47-55, Fig 4 described col. 7, lines 56-65 continue col. 8, lines 5-8, and Fig. 7 {C, D, E}, see discussion about "first license information" and "media ID" in 1a) below); and

c) encryption means for reading the second media ID and encrypting the key and a second license information, representing a second right to use the contents devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium, together with one another or individually with the read second media ID, to generate a second encryption secure information with the second media ID for storage in said second storage medium (Fig. 5, described col. 3, lines 14-33, Fig 2 (210, 218), described col. 6, lines 1-29 and col. 4, lines 16-26,

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wherein cited encrypting portion of a license, using special encryption algorithm, col. 3, lines 15-20 indicating availability of an "encryption means" in the reference system and some input {obtaining or extracting or reading} of information prior to performing encryption is an essential step, cited encrypting a value using random number as encryption key, col. 4, lines 43-45, pointing to reference's teaching or said encryption means using "encrypting key" together with "license information" as indicated by recitation of encrypting a portion of license using created enabler key comprising a serial number, number of connections allowed at one point, major & minor versions etc. col. 3, lines 16-24, and performing double encryption to each license, col. 5, lines 14-15 etc.. Moreover, recitation of encrypting a value in electronic license area at a position, col. 6, lines 1-3, writing the license set or license information to RAM, and copying the license set or information {col. 5, lines 15-17} to extraction database file, col. 6, lines 2-29 indicating license set or information on the extraction database file is a "second license information or set" and denoting or representing "second right to use" by the extractor or second user in the distribution chain, and said license information transferring or devolving from CD ROM, first storage medium, col. 4, lines 21-22 to said extractor's database file or second storage medium. Furthermore, as discussed above, said license information transferring from CD ROM {first storage medium} to the "next entity or successor's", secure directory of a computer system {second storage medium} wherein it is used, col. 4, lines 19-26. Again, reference's disabling procedure "disables or reduces or declines or degenerates" the number of licenses and contents or license information, such as serial numbers, number of connections, major and minor product

versions etc., col. 5, line 50 through col. 6, line 6; i.e., next entity or successor gets and uses only the portion which was disabled or reduced or degenerated, col. 6, lines 40-63.

Please see discussion about media ID in 1a) below);

In the following element:

a) storage medium accessing means for accessing a first storage medium storing contents encrypted with a predetermined key, storing a first media ID identifying the first storage medium, and storing a first encryption secure information generated by encrypting the key and a first license information that represents a right to use the contents, that represents a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium storing a second media ID identifying the second storage medium.

Ross et al teach:

storage medium accessing means (**Col. 1, line 55, wherein recitation of “accessible” points to availability of “accessing” function in the reference and said function clearly inferring presence of device, such as CD Rom drive or “means for accessing storage medium, CD, col. 1, line 46-47”**), for accessing a first storage medium storing contents encrypted with a predetermined key (Fig. 6B described col. 1, lines 46-51, Fig. 5 {Enabler Keys}, col. 3, lines 20-24 and Fig. 2 {210, 216, 218} described col. 6, lines 1-20, wherein cited CD Rom representing “first storage medium”, enabler key indicating “key or predetermined key {since construction or formation of said enabler key is decided prior {predetermined} to encryption”, said

enabler key comprising serial number, number of connections etc. representing "contents" which are encrypted using the created encryption key, col. 3, lines 20-24, and storing a first encryption secure information generated by encrypting the key and a first license information **(Col. 3, lines 21-41: a serial number, number of connections, major and minor product version identifiers, ten random numbers and three checksum values, the product and licensing combinations, lines 40-41 clearly inferring claimed "license information" stored on a storage medium {CD ROM, for instance} and a user would consider it a "first" when used by initial or first entity, such as manufacturer, Fig. 5 {1}), representing a right to use the contents (Col. 3, lines 44-45, wherein "product and license installed on end user's system" inferring that end user would then have the right to use the information {content} on the medium, such as CD Rom etc.), together with one another or individually (a user would use reference's "storing" function for storing above discussed "content" either with first media ID or both first and second media IDs using IDs discussed below);**

Ross et al do not teach:

a first media ID, identifying the first storage medium,

{storing} a second media ID identifying the second storage media.

However, Hasebe et al teach the same (Fig. 2 {12} described col. 4, lines 10-12, and col. 9, lines 1-9, wherein cited medium personal number representing "media ID", and any of the optical disk, CD ROM, floppy disk, hard disk indicating "second storage medium", each of them having its personal medium number or ID as per col. 9, lines 1-2

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recited with lines 6-9, and said personal medium number or medium ID indicating "identification of or identifying" its respective medium). While Ross et al providing a system for transferring license information on a storage medium from one entity to another entity's storage medium using encryption and decryption, Hasebe et al deal with protecting of copying electronic data from storage medium having a medium number to another medium; i.e., both are in analogous art.

It would have been obvious to one of ordinary skill in the license/information protection art at the time of applicant's invention to include Hasebe et al's media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

**Claim 2.** A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third license information, obtained through subtracting the second license information from a first license information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure information in the first storage medium (Ross et al: Fig. 2 {210, 218}, Fig 5 {A, B}, Fig. 5 {any of 2-4 being considered as third user of the third right of using and obtained by eliminating or subtracting the second right of using from the first right of using and col. 3, lines 40-45, and see discussion about "licensing information" and discussion about "media ID" in claim 1a) above. Moreover, the license information would first, second, third etc. when used by any of 1-4 entities of Ross et al's Fig. 5).



**Claim 3.** A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium (Claim 1, lines 37-41, col. 4, lines 8-15 and col. 6 through col. 7, line 20), the first encryption secure information stored in the first storage medium is destroyed (Ross et al: Fig. 1 {102}, col. 4, lines 16-18. Applicant will appreciate that a user would use reference's disabling function/process to disable or erase or delete or destroy the secure information stored in the first storage medium after transferring the information to another/second etc. media).

**Claim 4.** A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents (Figs. 6A and 6B described col. 1, lines 31-61), and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents (Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherent).

**Claim 5.** A license devolution apparatus according to claim 2, wherein the first license information and the second license information represent the presence of the right to use, and the third license information represents the absence of the right to

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use (Fig. 5, any of 2-4 functioning as a first user of first use information, a second user of second use of information and when two are using the use information, third one, say, installer, would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all, see discussion about license information in claims 1a) and 2) above).

**Claim 6.** A license devolution apparatus according to claim 2, wherein the first license information represents of a first available number of times or available time, the second license information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third license information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time (Inherent, since the user under the agreement would be obliged to use the product {document, picture or program} for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times, and see discussion about license information in claims 1a) and 2) above).

**Claim 7.** A license devolution apparatus according to claim 1, wherein the first and second storage media form a composite storage unit (See discussion about composite storage unit in Applicant's claim 10 below), the composite storage unit further

comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively (Inherent, since the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same),

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit (Inherent, since softwaers/firmwares including first and second softwaers/firmwares relating to any device or means including decoding and encryption means are installed in different partitions of a memory functioning as composite unit); and

wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive (Inherent, since each driver {software/firmware} would {have authority} run its respective media having an ID and access the information on it).

**Claim 8.** A license devolution method, comprising:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first license information,

which represents a right to use the contents (See discussion of Applicant's claim 1a) above);

b) decoding the first encryption secure information using the first media ID to obtain the key and first use information (See discussion of Applicant's claim 1b) above);

c) generating a second encryption secure information by reading a second media ID identifying a second storage medium and encrypting with a second media ID, the key and second license information, which represents a second right to use the contents that is devolved from the first license information stored on the first storage medium by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium (See discussion of Applicant's claim 1c) above); and

d) storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium (See Applicant's claims 1a) and 1c) above).

**Claim 9.** A license devolution system in communication with computer readable storages (Ross et al: Col. 2, lines 41-44 recited with lines 1-7 and col. 3, lines 6-11 {specifically lines 6-8, reciting: The present invention employs a scheme for creating, extracting, **transferring (devolving)**, enforcing and managing electronic licenses}), comprising:

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a) an access unit accessing a first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing a second storage unit having a second storage ID identifying the second storage unit (See the discussion of Applicant's claim 1a) above. Applicant will appreciate that reference's accessing function clearly points to the presence of "an access unit" in the system);

b) a decoder decoding the first encryption secure information stored in said first storage unit by reading the first storage ID and using the first storage ID to obtain the key and the first license information (See the discussion of Applicant's claim 1b) above);

c) a devolving unit devolving the right to use the contents of the first storage unit to the second storage unit by generating a second license information that represents a second right to use the contents devolved from the first license information stored on the first storage unit by passing down the first license information of the first storage medium to the second storage unit as a successor of the first storage medium and degenerating the first license information in the first storage medium (See discussion about devolving in Applicant's claim 1c) above. Applicant will appreciably realize that reference's transferring function, col. 3, line 7, indicating the presence of a "transferring or devolving unit"); and

d) an encryption unit reading the second storage ID, and encrypting the key and the second use information with the read second storage ID to generate a second encryption secure information stored in said second storage unit (See discussion of Applicant's claim 1c) above).

Claim 10. A license devolution computer, comprising:

b) a decoder decoding the first encryption secure information stored in said first storage unit by reading the first storage ID and using the first storage ID to obtain the key and the first license information; and

c) a devolving unit reading the second storage ID and devolving the right to use the contents of the first storage unit to the second storage unit by generating a second license information, which represents a second right to use the contents devolved from the first license information stored on the first storage unit by passing down the first license information of the first storage medium to the second storage medium as a successor of the first storage medium and reducing the first license information in the first storage medium according to the passing down, and encrypting the key and the second use information with the second storage ID to generate a second encryption secure information stored in said second storage unit.

In the following element:

a) a composite storage unit comprising a first storage unit, a second storage unit, and a composite storage access unit accessing the first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first

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encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing the second storage unit having a second storage ID identifying the second storage unit.

Ross et al teach:

accessing the first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first encryption secure information generated by encrypting the key and a first license information, which represents a right to use the contents, with the first storage ID, and accessing the second storage unit having a second storage ID identifying the second storage unit (See discussion of Applicant's claim 1a) above).

Ross et al do not teach:

a composite storage unit comprising a first storage unit, a second storage unit, and a composite storage access unit.

However, use of a compartment or composite storage unit having areas for various storage devices, such as diskette, CD, Hard Drive etc. {first, second storage units} is well known and practiced in the computer arts since long before Applicant's invention. Moreover, said storage devices using a software program, called driver or engine, obtain or access information from various input components, such as keyboard, mouse, display etc., (See enclosed pages 12 and 13, Ron White's How Computers Work, sixth edition), such a combined facility or composite unit enables a user to easily store any small or large size data in the requisite storage device or unit.

It would have been obvious to one of ordinary skill in the computer arts at the time of Applicant's invention to advantageously incorporate a well known and practiced facility in the combination of Ross et al and Hasebe et al's invention, thereby entailing a system with multiple storage devices and provide a user ease of storage capacity.

### ***Response to Arguments***

7. Applicant's arguments filed February 18, 2004 have been fully considered, but the same are not persuasive.

Applicant in argues that:

a) Ross et al's disabling procedure does not reduce or degenerate license while passing down from one entity's storage medium to the next entity's or successor's storage medium.

In this regard, Applicant is referred to Ross et al's col. 3, lines 15-24 recited with lines 40-45, wherein "a portion" of a license is encrypted, which portion is disabled or doubly encrypted using a special encryption program and during encryption process an enabler key is generated which is used by the next receiver or successor of said disabled portion of the license to enable it and then use it. This is further depicted in Fig. 1, described col. 4, lines 16-26, wherein at block 102, disableLicenSets procedure disables one or more sets {portion or portions} of licenses, lines 16-18. At block 106, setsToDistribution Media process receives, extracts and "transfers or devolves" licenses to CD ROM, lines 20-22. At block 108, licenseEnablement procedure decrypts "disabled portion or portions" of the license sets, lines 23-24, and at block 110, said enabled



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{portion or portions of license sets} copied to a secure directory of a computer system wherein the license {enabled portion} is used, lines 25-26. In other words, next user or successor {extractor or distributor or end user} gets only a "reduced or degenerated" portion or portions of the license from the original provider, manufacturer or fulfillment agent etc.. Moreover, license information is stored on entity's storage or first storage medium or, such as CD ROM etc. and transferred or devolved to next or successor entity's storage or second storage medium, like database file, database encompassing any storage device: diskette, CD, HD etc.. Thus, Ross et al's disabling process or procedure reduces or declines or degenerates the information or content or license information being "transferred or devolved" while "passing down" the same from one entity's storage device {first storage medium} to "next user or successor's" storage device {second storage medium}.

b) Ross does not teach license devolution using two storage mediums of the transferor and the transferee and their media IDs.

Regarding this, Applicant's attention is diverted to above discussion wherein one entity, such as manufacturer, fulfillment agent etc. functioning as transferring or performing devolution or transferor of license information on a storage device or medium, like CD ROM etc. to the next entity functioning as transferee receiving transferred or devolved license information on another or second storage device, such as database file and database encompassing any of storage device: diskette, CD, HD etc..

Ross et al do not explicitly teach storage device or media ID, it is where Hasebe et al was introduced which teach the same (Fig. 2 {12}, col. 4, lines 10-12, reading: "the storage medium includes medium personal number, and said personal unequivocally indicating claimed "storage medium ID". Moreover, storage medium encompassing optical disk, CD ROM, floppy disk, hard disk etc., col. 9, lines 1-9. A reasonable motivation for combining the two references was provided.

c) References do not teach: devolution as "passing down the license information of the first storage medium to the second storage medium as a successor of the first storage medium and degenerating the first license information in the first storage medium.

In this respect Applicant is directed to the discussion at a).

d) Ross et al do not contemplate using transferee storage information to protect transferred license.

Relative to this, Applicant is referred to the discussion at b) above, wherein it is stated that Hasebe et al was introduced for this reason.

Moreover, Applicant is reminded the following Case Law:

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

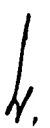
In the light of above mentioned facts, Examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and prior rejection is maintained.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is 703-308-6683. The examiner can normally be reached on 10:00 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 and for after Final 703-872-9327.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
M. Irshadullah  
May 06, 2004

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600